

REMARKS

I. Claim Status

Claims 61-119 are currently pending and stand rejected. No amendments to the claims are made herein.

II. Claim Rejections

Enablement Rejection

Claims 108-112 and 115 have been rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Office Action at 2. Applicants respectfully traverse this rejection.

35 U.S.C. § 112, first paragraph requires the specification to enable one of skill in the art to make and use the invention without undue experimentation. See M.P.E.P. § 2164.01 (citations omitted). Applicants assert that the current specification combined with the general knowledge in the art at the time the application was filed fully enables claims 108-112 and 115, which relate to methods of treating or preventing various conditions. For example, on page 5, lines 16-31, the specification discloses the utility of a related but patentably distinct compound tetradecylthioacetic acid (TTA) for treating those conditions encompassed by the rejected claims, referencing international patent application publications: WO 02/26218, WO 02/03983, and WO 02/43728. See bullet points 5-7. In each of those international patent application publications, experimental methods are provided to determine the biological activity of a specific compound. Armed with this information combined with the methods disclosed in the present specification for preparing compounds of the invention, one of skill in the art would be enabled to make and use the invention within the scope of claims 108-112, and 115. To be sure, as the Examiner points out, a large number of compounds fall

within the scope of the present claims. Office Action at 3. However, the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. M.P.E.P. § 2164.01. As a result, the present specification is enabling, and this rejection should be withdrawn.

Double Patenting Rejection

Claims 61-119 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 9, 13, 20-23, 32, 33, 39-44, and 48 of copending Application No. 10/484,855, and claims 101 and 116-119 have been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 27 and 37-41 of copending Application No. 10/55,129 or claims 143 and 154 of copending Application No. 10/550,033. Office Action at 5-6. Applicants respectfully traverse this rejection and request that the rejection be held in abeyance until claimed subject matter has been found to be allowable.

Provisional Rejection Under 102(e)/103

Claims 61-119 and claims 101 and 116-119 have been provisionally rejected under 35 U.S.C. § 103(a) as being obvious over Application No. 10/484,855 and Application Nos. 10/55,129 and 10/550,033, respectively. Office Action at 6-7. Applicants respectfully traverse these rejections.

The Examiner appears to be using the cited copending applications: 10/484,855 (US 2004/0219202); 10/55,129 (US 2007/009608); and 10/550,033 (US 2007/0015795), as prior art under 35 U.S.C. § 102(e). Applicants respectfully point out that the corresponding international applications for 10/55,129 (US 2007/009608) and

10/550,033 (US 2007/0015795) were filed *after* the present application was filed as an international application. Additionally, neither case claims priority of a prior U.S. application. Accordingly, these two patent publications have a 102(e) date after the filing date of the present application and, therefore, are not prior art and any rejection over them should be withdrawn. Furthermore, Applicants remove 10/484,855 (US 2004/0219202) as a prior art document based on the priority claim under § 119(a)-(d) to GB 0214267.7, filed on June 20, 2002, and GB 0217506.5, filed on July 29, 2002. Certified copies of those documents were made of record when the current application entered the national stage application under § 371 on December 17, 2004.

Rejection Under 102(f)/103 or 102(g)/103

Claims 61-119 have been rejected under 35 U.S.C. § 102(g)/103 as being unpatentable over US 2004/0219202 to Fletcher et al. Office Action at 9. Applicants respectfully traverse this rejection. As Applicants have discussed above, this document has been removed as prior art based on the priority claims to GB 0214267.7, filed on June 20, 2002, and GB 0217506.5, filed on July 29, 2002. As a result, this rejection should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Application No. 10/518,427
Attorney Docket No. 10260.0013-00000

Respectfully submitted,

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